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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,970	10/24/2003	Steven M. Blumenfeld	06975-342001	6970
26171 7590 10/16/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,970

Applicant(s)

BLUMENFELD ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/4/04, 9/15/06, 11/30/06, 12/23/09, 1/6/11
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-32 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 recites "using the profile to analyze a content request with a multi-tiered rule base that includes two or more of a medium rule base, a media player rule base and a host rule base". However, it is unclear to one of ordinary skill how the rule bases are used to analyze the content because, according to the claim the only information that is used to analyze the content request is the profile associated with the medium (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). For purposes of examination, Applicant's "analyzing" step is interpreted as follows: using the profile to analyze a content request with a multi-tiered database.

Claims 20 and 32 are also rejected and interpreted as above, as each recites language similar to claim 1.

Claims 2-19 and 21-31 are also rejected as each depends from either claim 1 or claim 20.

b. Claims 4 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a step of accessing the content and reading the medium, respectively, in claim 1.

c. Claim 8 recites "identifying priorities for rule bases with the multi-tiered rule base...". However, claim 1 is silent using the rule bases to analyze content. Further, claim 8 suggests that all of the rule bases are used, while claim 1, from which claim 8 depends, only requires two out of the three. Hence, it is unclear one of ordinary skill how Applicant utilizes the rule bases to determine access to selected content (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

d. The term "transparent" in claim 17 is a relative term which renders the claim indefinite. The term "transparent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree,

and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 8-20 and 23-32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hirota et al. U.S. Patent No. 6,606,707.

As per claims 1-5, 8, 15-17 , 20, 23 and 32, Hirota et al. teach a method of regulating access to a content selection comprising:

- accessing a medium associated with a content selection and identifying a profile (e.g. reference or serial number) associated with the medium (figures 5 and 9; column 10, lines 31-42; column 15, lines 3-15)

- using the profile to analyze a content request with a multi-tiered database (transparent to the user) (column 15, lines 10-15 and 55-62-e.g. first tier, column 15, lines 15-20-e.g. second tier; column/line 16/63-17/10-e.g. third tier)
- enabling access to the content selection in accordance with the analysis (column 15, lines 25-62; column 17, lines 11-46)
- identifying a user accessing the content (column 8, lines 9-34)
- analyzing the request by polling a first rule base first then a second rule base (column 15, lines 10-20 and 55-62; column/line 16/63-17/10)
- determines an access right without challenging a user (column/line 16/63-17/10)

Claims 9-14, 18, 19, 24-31, recite steps that do not necessarily have to be performed. However, it has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 II C).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota et al., U.S. Patent No. 6,606,707 in view of Ginter et al., U.S. Patent No. 5,892,900.

As per claims 6-7, 21 and 22, Hirota et al. teach a user purchasing and downloading content from a remote source (column 8, lines 1-20) and a user requesting the content subsequently stored on a medium (figure 9). Hirota et al. do not specifically recite reporting the content request to a reporting agent. Ginter et al. teach reporting to a reporting agent how content is used (column 318, lines 30-58; column 319, lines 5-14) and aggregating multiple requests associated with a media player and reporting the multiple requests to a host (column 318, lines 1-5 and 12-30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hirota et al. and Ginter et al. in order to allow the content provider of Hirota et al. ('707, column 8, lines 1-20) to better market their content to users ('900, column 318, lines 7-30).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kupka et al. teach downloading content to a medium using a medium identifier

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Lloyd Hewitt II
Primary Examiner

September 17, 2007